

Remarks

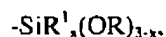
Claims 1-16 stand rejected. Claim 1 has been amended, and support for this amendment may be found at paragraphs [0016], [0019], [0025], and [0037], and the examples. New claims 17 and 18 have been added. New claim 17 finds support at paragraphs [0016], [0019], and [0025], and the examples of the specification. New claim 18 finds support at paragraphs [0016], [0025], and [0037], and the examples of the specification.

The advisory action at page 2, Attachment to the Advisory Action, indicates that applicants' proposed amendment in response to the final rejection was filed on May 27, 2008. The applicants respectfully request amendment of the advisory action to reflect that the proposed amendment in response to the final rejection was filed on May 22, 2008, which was within the 3 month time period for response. A copy of the Certificate of Mailing showing that the response was in fact filed on May 22, 2008 is attached to this Amendment as Exhibit 1.

The examiner rejected claims 1-16 under 35 U.S.C. § 102(b) over U.S. Patent 6,132,664 (Freiberg) arguing that Freiberg discloses a moisture curable composition comprising an organopolysiloxane having not less than two silicon-bonded alkoxy/hydrolyzable groups and an alkoxysilane having the formula $R^4_xSi(OR)_{4-x}$ where x can be 0, 1, or 2 and that when x is equal to 2, the organosilane has the formula $G_2-Si-R^1_2$. The examiner further argues that Freiberg discloses that the composition further comprises a filler and a photocatalyst. The examiner further argues Freiberg discloses that when the alkoxysilane does not contain an unsaturated group, then component (c) is provided which can be a short chain siloxane.

Freiberg discloses a composition comprising:

(A) polymers comprising on average at least 1.2 alkoxysilyl chain terminations per molecule described by the formula

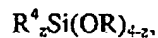


where each R is independently selected from the group consisting of methyl, ethyl, n -propyl, isopropyl, n -butyl, sec -butyl, and isobutyl, R^1 is selected from the group consisting of methyl and ethyl, and x is 0 or 1.

(B) a titanate compound comprising on average at least three alkoxy radicals bonded to titanium.

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(C) an alkoxysilane described by formula



where each R^4 is independently selected from monovalent hydrocarbon radicals comprising from 1 to about 12 carbon atoms, each R is as defined above, and z is 0, 1, or 2, and

(D) a filler (col. 2, line 42-col. 3, line 16).

In the examples, Freiberg does not use any polymers or alkoxysilanes or any other species that contain vinyl or any other unsaturated group in the compositions. Freiberg teaches away from using titanate compounds having fewer than an average of three alkoxy radicals bonded to titanium (col. 2, line 42-col. 3, line 16 and col. 10, Example 2C). Freiberg does not disclose curing the compositions in the presence of light. Freiberg does not disclose any method for surface modification of cured products of the compositions. Freiberg does not teach or suggest any composition or method for preparing an elastomeric product having a surface with a maximum gloss value of 45.

A genus does not always anticipate a claim to a species within the genus (MPEP §2131.02). For example, In re Meyer, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979) provided that '[a] reference disclosing "alkaline chlorine or bromine solution" embraces a large number of species and cannot be said to anticipate claims to "alkali metal hypochlorite."'. Akzo N.V. v. International Trade Comm'n, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) provided that '[c]laims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.'

The applicants respectfully disagree with the examiner's construction of Freiberg and submit that the instant situation is analogous to that in In re Meyer. Freiberg discloses a large genus, not a genus of only two species as suggested by the examiner, and Freiberg does not suggest the invention claimed herein. The composition of this invention consists essentially of a) an organopolysiloxane having not less than two silicon-bonded hydroxyl or hydrolysable groups; b) a silane substantially having the formula $G_2-Si-R^1_2$, wherein each group G is the same or different and is selected from the group consisting of alkoxy, acetoxy, oxime, and hydroxy groups, and each R^1 independently represents an alkyl group having from 1 to 10 carbon atoms, an alkenyl group, an alkynyl group, an aryl group such as phenyl, or a fluorinated alkyl group; c) one or more fillers and d) a photocatalyst; wherein, when no R^1 group is either an alkenyl or alkynyl group there is provided: e) an unsaturated compound selected from the group of an unsaturated

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short chain siloxane, an unsaturated cyclic siloxane, an unsaturated fatty acid, an unsaturated fatty alcohol and an unsaturated fatty acid ester. The composition is capable of cure to an elastomeric body has a surface with a maximum gloss value of 45.

No silane cross-linkers having the formula $G_3 - Si - R^1$ or $G_4 - Si$, where G and R^1 are present in the composition and method of the present invention [0020]. In contrast, Freiberg discloses a plurality of alkoxysilanes as being useful at col. 6, lines 47-57, and these include methyltrimethoxysilane, methyltriethoxysilane, phenyltrimethoxysilane, dodecyltrimethoxysilane, ethyltrimethoxysilane, ethyltriethoxysilane, and tetraethoxysilane, which represent numerous species outside the scope of the present invention, not to mention the partial hydrolyzates also mentioned by Freiberg. Freiberg discloses a large genus including many species for use as the cross-linker that fall outside the scope of the claims of this invention.

Furthermore, Freiberg discloses the titanate catalyst must have on average at least three alkoxy radicals bonded to titanium, preferably 3.6 to 4 alkoxy radicals bonded to titanium (col. 5, line 53 to col. 6, line 8). As shown in the comparative examples in the attached affidavit, when the catalyst of Example 1A is replaced with a preferred catalyst according to Freiberg, initial gloss is 45 (as compared to gloss of 22.6 in Example 1A according to the present invention). Furthermore, when the catalyst of example 4A is replaced with tetrabutyl titanate, which is a preferred catalyst according to Freiberg, initial gloss is 56, which is comparable to the gloss in example 4A in the original application. Therefore, one skilled in the art would not have a reasonable expectation of success to arrive at this invention based on the disclosure of Freiberg because he would not know which combination of components to choose to achieve the matte finish based on the disclosure of Freiberg.

Freiberg does not teach or suggest unsaturated groups are required, or provide any benefit, in the compositions of Freiberg. Freiberg suggests that unsaturated groups are NOT required because none of the examples of Freiberg employ any components with any unsaturated groups. In contrast, example 1 of this invention shows the unexpected benefit of improved gloss and surface modification by the incorporation of an unsaturated (e.g., vinyl containing) component (paragraph [0056]). By adding a vinyl containing dialkoxysilane cross linker component to example 1A, gloss improves to a value of 22.62 as compared to example 1B in which no unsaturated component is used and gloss is 82.74 (paragraph [0057] and table). By adding a vinyl containing dialkoxysilane cross linker component to example 1A.

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gloss improves to a value of 22.62 as compared to example 4A, in which a trialkoxysilane crosslinker is used and gloss is 59.72 (paragraph [0062] and table).

In the office action dated 22 February 2008, the examiner seems to argue that the applicants must present evidence that the claimed composition and the composition of Freiberg are not substantially identical, and the examiner seems to further argue that the instant application contains inadequate disclosure as to how to obtain the claimed properties with the claimed ingredients. The applicants respectfully disagree because multiple examples and comparative examples are provided at paragraphs [0047] – [0072] showing how to select ingredients, combine them, and cure them to provide a cured product having an air-scalant interface surface with a maximum gloss value of 45.

For example, example 1A of this invention and comparative example 1B show the benefit of using an unsaturated group containing cross linker over a composition in which no unsaturated component is used. Example 1A has gloss of 22.62, but comparative example 1B has gloss of 82.74 (p. 20), thereby showing that Example 1A of the invention has a matte finish and comparative example 1B does not. Comparative example 1B is outside the scope of this invention but includes preferred polydiorganosiloxane and filler of Freiberg (at col. 3, lines 35-41 and 44-46; and col. 7, lines 1-11 and 15-17).

Examples 1A and 4 in this invention show the benefit of using an unsaturated dialkoxysilane crosslinker over a trialkoxysilane crosslinker. Example 2 shows the benefit of using ingredient e) in a composition in which ingredient b) does not contain an unsaturated group. With respect to claim 15, examples 7A, 1A, and 7B show the benefit of curing in the presence of light. For these reasons, claims 1-18 are novel and unobvious over Freiberg, and applicants have presented evidence of this.

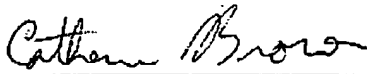
The cited reference fails to disclose the specific combination of components claimed herein, benefit provided thereby, and how to combine the components to achieve the benefit. The instant invention is novel and unobvious. Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

The applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are

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authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,
Dow Corning Corporation



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